

AI-TECH-16B

PATENT APPLICATION
Serial No. 10/774,882REMARKS

Claims 1-23 are pending in the captioned Application in which the Examiner has required restriction of claims 1-20, and in which claims 21-23 are newly added.

Restriction:

The Examiner has required restriction to Group I comprising claims 1-16 directed to a dielectric electronic substrate or Group II comprising claims 17-20 directed to a method.

Applicant hereby elects to initially prosecute claims 1-16 of Group I, and respectfully traverses the restriction requirement. New claims 21-23 are also properly in Group I.

The restriction should be withdrawn because the Examiner's stated reason therefor is incorrect. Examiner states that "In the instant case the product as claimed can be made by another and materially different process, for example conductive vias of the substrate can be made by drilling, etching, or stamping instead of plating." Drilling, etching or stamping are operations that would result in a hole or opening being formed, and would not result in a "conductive via" being provided. This is contrary to MPEP §803 which states "Examiners must provide reasons and/or examples to support conclusions." Moreover, both the article claims and the method claims recite openings for conductive vias without specifying how the openings are formed, so the Examiner's purported reason also fails in this regard.

It is submitted that in searching product claims 1-16 the Examiner is likely to search references and classifications that are likely to also disclose methods that may be similar to that of claims 17-20, and that for such search to be complete, the Examiner should also search the art classifications pertaining to the method of claims 17-20 which may also disclose various products that may be similar to those as recited by claims 1-16.

In addition, it is submitted that extent of the search required for examining either the Group I or the Group II claims is not substantially different from that required for examining all the claims because the references that disclose an article also in many instances also describe the method for making the article. For example, U.S. Patents 6,288,905 and 6,376,769, which issued from the priority applications in the present application, both include claims directed to an article and claims directed to the method for making the article, as the case with respect to the claims of Groups I and II of the present application. Other references cited in U.S. Patent 6,376,769 are similar. For example, the Yamaji and the Okoshi et al references describe both the prior art article and the method for making the prior art article.

Thus, the search required if all of claims 1-20 and 21-23 are examined is not

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necessarily more complex or extensive than that for claims 1-16.

In addition, Claims 1-16 directed to the electronic substrate article comprise elements that are substantially like the elements recited, for example, in method claims 17-20. As a specific example:

GROUP I — CLAIMS 1-16 ELECTRONIC SUBSTRATE	GROUP II — CLAIMS 17-20 METHOD FOR MAKING
A first layer of molecularly flexible dielectric adhesive having a modulus of elasticity less than about 500,000 psi, having a glass transition temperature less than about 0°C, and having the ability to withstand soldering at a temperature of about 220°C. [claim 9]	Providing on one surface of the sheet of metal foil at least one layer of a molecularly flexible dielectric adhesive having a modulus of elasticity less than about 500,000 psi, having a glass transition temperature less than about 0°C, and having the ability to withstand soldering at a temperature of about 220°C. [claim 17]
A first metal foil on a first exposed surface of said first layer of molecularly flexible dielectric adhesive, wherein said first metal foil is patterned to define a pattern of first electrical conductors having a plurality of contact sites for receiving the contacts of an electronic device. [claim 9]	Patterning the metal foil to form a pattern of contacts and conductors electrically connected to the conductive vias in the molecularly flexible dielectric adhesive layer. [claim 17]
A plurality of electrically conductive vias through said first layer of molecularly flexible dielectric adhesive.... [claim 9]	Building up conductive material on the metal foil to fill the via openings, thereby forming conductive vias therein. [claim 17]

Thus, the elements of the Group I article and of the Group II method are similar and so the searching required for examination of all of the claims pending should not be substantially greater than is that for examining only the claims of elected Group I, for example.

In addition, the restriction made by the Examiner between article and method claims in the priority application that issued as US Patent 6,376,769 was withdrawn upon argument similar to that herein, and both method and article claims were issued in the same Patent. Thus, consistency requires like action in the present Application.

Applicant's response herein provides reasons overcoming the rebuttable presumption accorded the Examiner for making a *prima facie* explanation in an *initial* restriction requirement and the requirement should be withdrawn. MPEP §803.

In this case, because "search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits, even though it contains claims to independent and distinct inventions." MPEP §803 (emphasis added).

"It still remains important ... that no requirements be made which might result in the

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issuance of two patents to the same invention." MPEP §803.01.

Newly Added Claims 21-23:

Support for newly added claims 21-23 is found, for example, in the specification at paragraphs 058, 069, 078-079 and 081, and in original claims 11 and 17.

Claims 21-23 are properly part of the elected Group I claims because they are directed to features of the molecularly flexible dielectric electronic substrate to which claims 1-16 are directed and because they depend from claim 1 or claim 9 of the Group I claims.


Conclusion:

Applicant respectfully requests that the restriction requirement be reconsidered in light of the foregoing and withdrawn, and that the Application including claims 1-23 be examined and allowed.

Please charge the fee of \$27.00 for increasing the total number of claims by three to Deposit Account 04-1406. A Fee Calculation sheet is submitted herewith. Should any other or additional fee be due in consequence of this response, please charge such fee to Deposit Account 04-1406.

The Examiner is requested to telephone the undersigned attorney if there is any question or if prosecution of this Application could be furthered by telephone.

Respectfully submitted,
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FEE TRANSMITTAL

Application Number: 10/774,882

Filing Date: February 9, 2004

First Named Inventor: Kevin Kwong-Tai CHUN

Group Art Unit: 2841

Examiner Name: Tuan T. Dinh

Total Amt of Payment (1) + (2) + (3) = \$27

Attorney Docket Number: AI-TECH-16B

METHOD OF PAYMENT (check one)

The Commissioner is hereby authorized to:

☒ Charge indicated fees☒ Charge additional fees☒ Credit overpayments

to the account of DANN, DORFMAN, HERRELL & SKILLMAN

Deposit Account Number 04-1406

Payment enclosed:

Check in the amount of \$ _____

FEE CALCULATION**1. FILING FEE**

Fee Description	Fee
Utility filing fee	_____
Design filing fee	_____
Plant filing fee	_____
Reissue filing fee	_____

SUBTOTAL (1) \$0**2. Claims Fees**

# of Claims - Paid	Extra Claims	Fee/Claim	Fee
Total Claims 23 - 20 =	3	9	\$27
Indep Claims 3 - 3 =	0	43	\$0

Multiple Dependent Claim Fee

SUBTOTAL (2) \$27**ADDITIONAL FEES**

Fee Description	Fee Paid
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Surcharge - late filing fee or oath

Surcharge - late provisional filing fee or cover sheet

Extension for response within month

Notice of Appeal

Filing a brief in support of an appeal

Request for oral hearing

Petition to revive unavoidably abandoned application

Petition to revive unintentionally abandoned application

Issue Fee

Petitions to the Commissioner

Petitions related to provisional applications

Submission of Information Disclosure Stmt.

Recording each patent assignment per property

Other fee (specify) Advance Order (10 copies)**SUBTOTAL (3)** \$0Submitted By: Clement A. Berard Reg. Number 29,613Signature  Date September 23, 2004

Deposit Account User ID

04-1406